

REMARKS

These remarks are made in response to the Office Action of August 21, 2006. At the onset, the Office Action did not set forth a period for reply. Under 37 C.F.R § 1.134, if no period for reply is specified, the maximum statutory period of six months from the mailing date of the Office Action will apply. Accordingly, Applicant believes that this reply is timely, and no extension of time fees are due with this response.

Claims 1-28 are pending in the present application. The Office Action indicated that claims 16-28 were allowable and indicated that claims 8 and 12 would be allowable if rewritten in independent form. Claims 1, 3, 5-7, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Erickson (U.S. Patent No. 3,363,763). The Office Action rejected claims 2 and 4 under 35 U.S.C. §103(a) as being unpatentable over Erickson in view of Hendrix (U.S. Patent No. 4,609,459). The Office Action indicated that remaining claims 9-11, 14 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson in view of Jardin (U.S. Patent No. 3,200,952).

Claims 1, 3, 5-7 and 13 are not Anticipated by Erickson

Claims 1, 3, 5-7, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Erickson (U.S. Patent No. 3,363,763). Of these claims, claim 1 is the only independent claim from which all others depend. Applicant respectfully submits that claim 1 is not anticipated by Erickson. Anticipation under §102 requires that each and every element as set forth in the claim

is found in a single prior art reference. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1381 (Fed. Cir. 2005). MPEP § 2131.

It is respectfully submitted that claim 1 is not anticipated by Erickson, as claim 1 recites that the screen is “mounted on the base member in engagement with the retainer surface.” Erickson does not disclose or suggest that the screen is mounted on the base member. On the contrary, Erickson discloses that the “inlet adapter 3” (identified by the Examiner as corresponding to the base member) receives the screen when secured to the valve body. Erickson states that:

By this construction, it is observed that the screen 13 can be easily removed and cleaned or replaced by simply removing the inlet adapter 3 **and sliding the screen from its position about the boss 17**. Col. 2, lines 48-51 (emphasis added)

The valve body, “inlet adapter 3,” and “boss 17” of Erickson are constructed such that the boss maintains the screen. The “inlet adapter 3” has a “chamfered face 14” to receive the screen once the screen is positioned on the boss (see col. 2, lines 34-35 “The wall 11 is provided to be a proper diameter for operably *receiving* the filter screen 13 therein.”). The screen is not mounted on the “inlet adapter” as suggested by the Office Action because the “inlet adapter” can be removed separately from the screen as stated at column 2, lines 48-51 (see above). Thus, it is respectfully submitted that Erickson does not disclose every element set forth in claim 1, and that claim 1 is not anticipated by Erickson.

In addition to rejecting claim 1, claims 3, 5-7 and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Erickson. Without specifically addressing each of the reasons

stated in the Office Action, it is respectfully submitted that remaining claims 3, 5-7 and 13 are not anticipated by Erickson, as Erickson does not anticipate independent claim 1 from which these claims depend. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112, para 4. "A claim is anticipated only if each and every element as set forth in the claim is found... in a single prior art reference." MPEP § 2131. As stated above claim 1 is not anticipated by Erickson because Erickson does not teach, suggest or disclose that the screen is mounted on the base member in engagement with the retainer surface as recited by claim 1. Thus, Applicant respectfully submits that claims 3, 5-7 and 13 are not anticipated, as Erickson at least does not anticipate independent claim 1, from which these claims all depend (*see supra*).

Claim 2 is Patentable over Erickson and Hendrix

The Office Action rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over Erickson in view of Hendrix (U.S. Patent No. 4,609,459). The Office Action indicates that Erickson discloses all the claimed features of claim 1, from which claim 2 depends. The Office Action relies on Erickson modified by the teachings of Hendrix to reject claim 2. It is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness based on Erickson as modified by Hendrix. A *prima facie* case of obvious requires a showing that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all of the claim limitations. MPEP § 2143

The Office Action fails to set forth a suggestion or motivation to modify Erickson in view of the very different filtering apparatus of Hendrix. “A statement that the modification to the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.” MPEP 2143.01(IV). The Office Action does not set forth an objective reason as to combine the pin and tabs of Hendrix with the internally, longitudinally positioned screen filter in Erickson. The filter of Erickson is disposed longitudinally (see col. 2, lines 55-57) and held in place by a cylindrical boss located in a “cylindrical filter chamber” (see col. 2, lines 40-41). The boss cooperates with the inlet adapter to position the screen filter axially within the filter chamber (see col. 2, lines 43-45). There is no teaching, motivation or disclosure in Erickson that suggests it is advantageous to align the screen or filter using a “plurality of locating devices” as recited in claim 2. Additionally, there is no motivation or suggestion that is advantageous to combine the exterior alignment pin or tabs of Hendrix (see col. 4, lines 12-20) with the internal boss, internal screen, and inlet adapter of Erickson.

The Office Action fails to address whether there would be some “expectation of success” in combining differing elements of Hendrix and Erickson. The Office Action fails to address how the external alignment pin and tabs of Hendrix could be incorporated into the internal filter screen configuration of Erickson with any possibility of success.

Finally, even if the combination of Erickson and Hendrix was warranted, the references fail to teach or suggest all of the claim limitations. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03 Claim 2 depends from claim 1. As stated above, Erickson does not teach, suggest or disclose that the screen is mounted on the base member in engagement with the retainer surface as recited by claim 1. Thus, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of obviousness and that claim 2 is patentable over the prior art of record.

Claim 4 is Patentable over Erickson and Hendrix

The Office Action rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Erickson in view of Hendrix (U.S. Patent No. 4,609,459). The Office Action indicates that Erickson discloses all the claimed features of claim 1, from which claim 4 depends. The Office Action relies on Erickson modified by the teachings of Hendrix to reject claim 4. It is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness. As stated above, the Office Action fails to set forth objective reasons for combining the pin and tabs of Hendrix with the internally, longitudinally positioned screen filter of Erickson. The Office Action also fails to set forth some "expectation of success" of combining differing elements of Hendrix and Erickson.

Furthermore, Erickson and Hendrix fail to teach or suggest all of the limitations of dependent claim 4. "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03. Claim 4 depends from claim 3 and independent

claim 1 and incorporates their limitations by reference. The limitations of claims 1, 3, and 4 are not disclosed, taught or suggested by either Erickson alone or Erickson in combination with Hendrix. Claim 1 recites a base member which defines an inlet and a screen mounted on said base member. Claim 3 depends from claim 1 and recites that the base member “defines at its inlet a radial end face.” Claim 4 further depends from claim 3 and recites at least one boss protruding from the end face.

It is respectfully submitted that Erickson fails to teach, suggest or disclose a base member with a radial end face at its inlet as recited in claim 3. Erickson also fails to disclose that the screen is mounted on the base member as recited in claim 1. Moreover, the Office Action fails to set forth how the tabs and pin of Hendrix in combination with Erickson teach or suggest a “boss on the end face” as recited in claim 4. Thus, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of obviousness and that claim 4 is patentable over the prior art of record.

Claims 9-11, 14, and 15 are Patent over Erickson in view of Jardin

The Office Action rejected claims 8-11 [sic], 14, and 15 under 35 U.S.C. §103(a) as being unpatentable over Erickson in view of Jardin (U.S. Patent No. 3,200,952). While claim 8 is listed among the rejected claims, the Examiner later indicated that claim 8 would be allowable if rewritten in independent form. As claim 8 does not recite the “legs” limitations, which form the basis of this §103 rejection, Applicant believes that this is a typographical error and that only claims 9-11, 14, and 15 were rejected.

The Office Action indicates that Erickson discloses all the claimed features with the exception of the limitations found in claims 9-11, 14, and 15. The Office Action relies on Erickson modified by the teachings of Jardin to reject claims 9-11, 14, and 15. However, it is respectfully submitted that the Office Action does not establish a *prima facie* case of obviousness and that claims 9-11, 14, and 15 are patentable over the prior art of record.

Claims 9-12 are Patentable over Erickson in View of Jardin

It is respectfully submitted that claim 9 and all the claims that incorporated by reference (claims 10-12) are patentable in view of Erickson and Jardin. It is respectfully submitted that the Office Action does not establish a *prima facie* case of obviousness, as the Office Action at least fails to identify an objective reason, suggestion or motivation for combining the features of Jardin with those of Erickson and that, even if such a combination was warranted, the references do not teach or disclose all the limitations of claim 9.

The inventions of Jardin and Erickson are different and unsuitable to form obviousness rejection without objective reasons. "A statement that the modification to the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the invention was made because the reference relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP 2143.01(IV). The Office Action does not identify a specific statement or objective reason from Jardin or Erickson which explain that modification to the prior art would meet all of the

limitations of claim 9. On the contrary, it is respectfully submitted that one skilled in the art would not considered adding legs to Erickson in the manner proposed by the Office Action.

The Office Action suggests that one skilled in the art would have employed the “ribs” (identified by the Examiner as corresponding to the “legs” as recited in the claims) for the “purpose of preventing the filter element from collapsing as recognized by Jardin.” (page 5). Erickson discloses a screen that filters fluid as the fluid moves from the interior to the exterior (see col. 2, lines 58-61). The screen filter of Erickson would never “collapse” as fluid is passing from the interior of the screen to the exterior. The pressure from the fluid flow would prevent the screen from “collapsing.” Thus, one skilled in the art would have no motivation to add legs as recited in claim 9 to the base member.

Finally, Erickson and Jardin fail to teach or suggest all of the claim limitations. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03 Claim 9 depends from claim 1. As stated above, Erickson does not teach, suggest or disclose that the screen is mounted on the base member in engagement with the retainer surface as recited by claim 1. Thus, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of obviousness and that claims 9-12 are patentable over the prior art of record.

Claims 14 and 15 are Patentable over Erickson in View of Jardin

It is respectfully submitted that claims 14 and 15 are patentable over Erickson and Jardin as the Office Action fails to set forth a *prima facie* case of obviousness. The Office Action fails

to set forth an objection reason or motivation for modifying the “left facing surface of flange 10 supporting screen 13” of Erickson (Office Action, page 2), which is clearly located in the interior of the “inlet adapter 3,” (identified by the Examiner as corresponding to the base member) to create an axial retainer surface “on the outside diameter of the base member” as recited in claim 14. The Office Action fails to address whether the “inlet adapter 3” could be successfully modified to have an axial retainer surface on its “outside diameter” such that the adapter could “receive” the screen member and be secured to “inlet 2” as depicted in Figure 1 of Erickson. It is respectfully submitted that such a modification is impossible or would render the construction of Erickson inoperable.

Moreover, it is respectfully submitted that the combination of Erickson and Jardin do not teach or suggestion all of the limitations of claims 14 and 15. Claim 15 is dependent on claim 14, which in turn is dependent on claim 1. As stated above, Erickson does not teach, suggest or disclose that the screen is mounted on the base member as recited in claim 1. Therefore, claim 1 is not anticipated or obvious in view of the prior art of record. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03. For these reasons, it is respectfully submitted that claims 14 and 15, which depend from claim 1, are also nonobvious in view of the prior of record.

Dependent Claims 8 and 12 Are Allowable

Finally, Applicant turns to the Examiner’s indication that claims 8 and 12 would be allowable if written in independent form. At this time, Applicant does not wish to amend the

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claims because, as described above, Applicant respectfully submits that the claim 1 and the respective dependent claims are distinguishable over the prior art of record.

Conclusion

For the above reasons, is respectfully submitted that the application is now in condition for allowance. Accordingly, reconsideration and allowance of all the pending claims are respectfully requested.

Respectfully submitted,

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